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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,516	10/03/2000	Randy Gray Simmons	17499	5361

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EXAMINER

GUSHI, ROSS N

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 05/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/678,516

Applicant(s)

SIMMONS ET AL.

Examiner

Ross N. Gushi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1 and 4-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 08 January 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 21-28 been renumbered 16-23.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4 – 13, and 21-28 (renumbered as claims 16-23) are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoshita et al. ("Kinoshita").

3. Kinoshita discloses a modular jack connector assembly comprising a dielectric housing (11) having a front and rear orientation and defining at least one receptacle adapted for receiving a mating plug; and a plurality of contacts (12) disposed in said housing, each contact being secured to a rear portion of said housing (e.g. at 12a or 12e), each contact extending forward from said rear portion to a free end 12b such that a portion of said contact forward of said rear portion electrically connects with a mating plug when the mating plug is received within said receptacle, said housing has a rear

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side defining a slot (16) suitable for receiving an edge of a circuit board 15, and wherein a connection portion 12c of each contact extends from said rear portion of said housing into said slot such that when said housing is mounted to a circuit board a portion of said connection portion makes contact with the circuit board. To the extent that Kinoshita is not explicit in stating that the mating plugs are "RJ standard compliant," at the time of the invention, it would have been obvious to have the connector be mateable with "RG standard compliant" plugs. The suggestion or motivation for doing so would have been to allow the connector to be used with standardized parts, as suggested in Kinoshita, col. 1, lines 10-15, and as is well known in the art.

4. Regarding claims 5, 6, 7, 11, 12, 21, 22, 23, 24, 25, and 28, regarding the relative dimensions, strengths, and proportions of the contact, it is impossible to tell whether the Kinoshita contacts meet the claimed limitations or not, especially given that the referenced "RJ-standards" were not even in existence at the time the Kinoshita patent was published. However, at the time of the invention, it would have been obvious to one with ordinary skill in the art that the contact dimensions, strengths, or proportions could be varied as desired. The suggestion or motivation for doing so would have been for example to improve durability and to obtain desired compliance, such motivations being well known in the art. Furthermore, the claimed variations in relative sizes, proportions, or dimensions, of the contacts, where the claimed device does not perform differently compared to the prior art device, do not patentably distinguish the claimed invention from the prior art. Gardner v. TEC Systems, Inc., 725 F.2d 1338 (Ct. App. Fed Cir. 1984).

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5. Regarding claims 26-28 and 8-10, to the extent that Kinoshita is not explicit in stating that the connector is configured to receive RJ-45 or RJ-11 standard plugs, at the time of the invention, it would have been obvious to construct the Kinoshita device so as to receive standard plugs. The suggestion or motivation for doing so would have been to allow the connector to be used with standardized parts, as suggested in Kinoshita, col. 1, lines 10-15, and as is well known in the art.

6. Per claim 13, the Kinoshita housing comprises one receptacle.

7. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoshita as in claim 1 in view of Laity '962. Kinoshita discloses a single receptacle housing, not a housing with two or more receptacles. Laity discloses a connector including a plurality of RJ-type receptacles. At the time of the invention, it would have been obvious to modify the Kinoshita connector to accommodate a plurality of RJ-type receptacles, as taught in Laity. The suggestion or motivation for doing so would have been to allow electrical connection to the circuit board via a variety of plugs or to connect the board to a variety of devices, as taught in Laity.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laity '962 in view of Kinoshita as in claim 1. Laity discloses a PCMCIA card comprising a card housing, a circuit board mounted in the card housing, and a modular jack connector comprising a housing and contacts. Arguably the Laity contacts are not secured at a rear portion of the housing. At the time of the invention, it would have been obvious to use the Kinoshita connector in the Laity card. The suggestion or

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motivation for doing so would have been to reduce the space required for the assembly as taught in Kinoshita (col. 1, lines 34-41).

Response to Arguments

2. Applicant's arguments filed 1/8/02 have been fully considered but they are not persuasive. Applicant argues that the term "RJ-standard" is not indefinite. The examiner is persuaded that the term is not indefinite and has withdrawn the 35 USC 112 rejections. However, the examiner notes that it may be impossible to determine whether or not relevant prior art (e.g. Kinoshita cited above or Free et al. cited by applicant) meets or deviates from the standard (without excessive physical experimentation on an physical device), especially where the prior art pre-dates the standard, as in Kinoshita.
3. Regarding Laity, applicant's arguments are moot in view of the new grounds of rejection.
9. Applicant argues that it would not be obvious to deviate dimensions from a standard. First, it is impossible to tell in most relevant prior art (e.g. Kinoshita) whether the prior art contacts would have met or deviated from standards promulgated after the invention. Similarly, for relevant prior art published after the standards, it is still generally impossible to tell whether the contacts meet or deviate from the standard, given that relative strengths and dimensions are often not included in patent applications. In any case, the relevant case law indicates that variations in the relative sizes, proportions, or dimensions, of the contacts, where the claimed device does not perform differently compared to the prior art device do not patentably distinguish the

claimed invention from the prior art. Gardner v. TEC Systems, Inc., 725 F.2d 1338 (Ct. App. Fed Cir. 1984).

Conclusion

Because the new grounds for rejection were not necessitated by applicant's amendment, this Office action is not made final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross Gushi whose telephone number is (703) 306-4508. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Paula A. Bradley, can be reached at (703) 308-2319. The phone number for the Group's facsimile is (703) 308-7722

rng

A handwritten signature in black ink, appearing to read "Ross Gushi", with a stylized flourish at the end.